

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Markus Frank et al.

Conf. No.: 1250

Application No.: 10/548748

Group Art Unit: 1638

Filed: September 8, 2005

Examiner: Ibrahim, Medina Ahmed

For: METHOD FOR INCREASING RESISTANCE
AGAINST STRESS FACTORS IN PLANTS

RESPONSE TO RESTRICTION REQUIREMENT

MS Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the restriction requirement set forth in the Office Action mailed December 19, 2006, Applicants provisionally elect Group I (claims 1-11 and 13-21) and the nucleotide sequence of SEQ ID NO: 1, and the corresponding polypeptide SEQ ID NO: 2, with traverse. Reconsideration and withdrawal of the restriction requirement is strongly urged for the following reasons.

The Claimed Inventions Share a Special Technical Feature

Because this application is a national stage filing pursuant to 35 U.S.C. § 371, unity of invention under PCT Rule 13.1 and 13.2 is the applicable standard. Unity of invention is fulfilled “when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical feature. The expression ‘special technical feature’ shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.” (PCT Rule 13.2).

The Examiner argues that the inventions of Groups I and II lack unity because they are directed to different products having different structures and function. The Examiner further

alleges that the only possible technical feature linking the claims is the fact that the polynucleotide of Group II is encoded by the nucleic acid of Group I, and such a feature is known in the art. Applicants respectfully disagree.

As stated in the specification, the invention relates to methods for generating or increasing stress resistances in plants by increasing the expression of at least one Bax inhibitor 1 (BI1) protein in at least one plant tissue, the polypeptide sequence of BI1 protein, and the polynucleotide sequence encoding the same. See Specification at page 1. Thus, the common technical feature shared by all claims of Groups I and II is the BI1 proteins and not the mere fact that a polypeptide is encoded by a nucleotide sequence as alleged by the Examiner.

Furthermore, as recited in the claims, the proteins of Restriction Group II are encoded by the nucleic acid sequences included within Restriction Group I, and the amount or the function of the proteins is increased by the methods of Restriction Group I. As noted in Chapter 10 (§10.59), Example 39, of the PCT International Search and Preliminary Examination Guidelines established by the International Bureau of WIPO for the determination of Unity of Invention, applicable to national stage applications under 35 U.S.C. § 371 (see MPEP § 1850), claims to a protein and its encoding DNA are to be considered together as having unity of invention, particularly when the protein is not known in the art. Because the nucleic acids of Group I encode the polypeptides of Group II, the claims of Group I and II have unity of invention as in Example 39.

It is also noted that Restriction Group I is not limited to nucleic acids, but encompasses in claim 1 the use of the proteins claimed in Restriction Group II (i.e. claim 12). The protein and its use involve the same technical feature.

Additionally, Applicants respectfully submit that the restriction requirement should be withdrawn even under restriction practice. As stated in § 803 of the M.P.E.P. “[i]f the search and examination of the entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.” (M.P.E.P. § 803, emphasis added). Because the same art relevant to a BI1 protein would also be relevant to a method of using it in increasing the amount or the function of the protein in genetically modified plants, there would be no undue burden on the Examiner to search and

examine both Groups together, since the subject matter of the various groups is so closely linked and would be classified together for search.

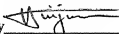
For these reasons, Applicants respectfully request that the restriction requirement be reconsidered and withdrawn entirely.

CONCLUSION

For at least the above reasons, Applicants respectfully request that the restriction requirement be reconsidered and withdrawn.

Accompanying this response is a petition for a two-month extension of time to and including March 19, 2007 to respond to the Office Action mailed December 19, 2006 with the required fee authorization. No further fees are believed due. If any additional fee is due, the Director is hereby authorized to charge any deficiency in the fees filed, asserted to be filed or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Deposit Account No. 03-2775, under Order No. 12810-00137-US from which the undersigned is authorized to draw.

Respectfully submitted,

By 
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